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Scott Jacobson, Esquire Honeywell International, Inc. 101 Columbia Road P.O. Box 2245 Morristown, NJ 07962-2245			EXAMINER CHEUNG, WILLIAM K	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRIAN L. GIBSON and FRED DURRENBERGER

Appeal 2009-002988
Application 10/766,430
Technology Center 1700

Decided:¹ August 4, 2009

Before CHARLES F. WARREN, CATHERINE Q. TIMM, and
JEFFREY T. SMITH, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

DECISION ON APPEAL

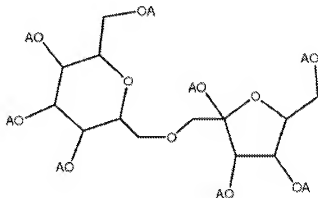
¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the Decided Date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

Statement of the Case

This is an appeal under 35 U.S.C. § 134 from a final rejection of claims 1-18, 67, and 71-85, all of the pending claims. We have jurisdiction under 35 U.S.C. § 6.^{2,3}

The claimed invention is directed to a process for extruding a resin composition. Representative claim 1 is reproduced below.

1. A process for extruding a resin-containing composition comprising:
 - a) providing an extrudeable mass comprising at least one extrudeable resin and at least one saccharide ester of Formula I



wherein each "A" is independently hydrogen or has the structure of Structure I:
Structure I

² In this decision we have considered Appellants arguments presented in the Briefs, filed March 27, 2008 and August 18, 2008.

³ An oral hearing for this appeal was held on June 23, 2009.



- wherein each "R" is independently an aliphatic or aromatic moiety of about eight to about 40 carbon atoms, and wherein all of the "A" moieties of at least about 50 wt. % of the compounds of Formula I comprise moieties of Structure I; and
- b) extruding said extrudable mass to produce an extrudate.

Appellants appeal the Examiner's rejection of claims 1-18, 67, and 71-85 as anticipated under 35 U.S.C. § 102 (b) by Kaneko, U.S. Patent no. 3,635,856, issued January 18, 1972 "as affirmed by" Mitsubishi Kagaku, "Introduction Of Sugar Esters" (2002), obtained from <http://www.mfc.co.jp/englishindex.html>. (Ans. 3).

The issue before us is whether Appellants have shown that the Examiner reversibly erred in rejecting the claims under 35 U.S.C. § 102(b). We answer this question in the affirmative. Therefore, WE REVERSE.⁴

The issue turns on whether Kaneko describes or suggests an extrudeable mass comprising at least one extrudeable resin and at least one saccharide ester of Formula I wherein all of the "A" moieties of at least about 50 wt.% of the compounds of Formula I comprise a moieties of Structure I.

The Examiner bears the initial burden of establishing a prima facie case of anticipation. *In re King*, 801 F.2d 1324, 1326-27 (Fed. Cir. 1986).

⁴ We select independent claim 1 as representative of the rejected subject matter.

Anticipation under 35 U.S.C. § 102 requires that “each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999).

The Examiner found that Kaneko describes an extrudeable mass comprising an extrudeable resin and at least one saccharide ester having a structure that is substantially identical to the saccharide ester of Formula (I) as claimed. (Ans. 3).

We agree with the Appellants that the generic composition disclosed in Kaneko encompasses an infinite number of species compositions and the Examiner based the rejection on the false premise that “a small number” of relevant species are involved in the generic teaching of Kaneko. (App. Br. 13). Kaneko discloses the extrusion of a PVC composition comprising a stabilizer composition. The stabilizer composition of Kaneko includes at least one additive selected from the group consisting of (a) sucrose alkyl ester and (b) a semiester of an organic polybasic acid. (See Abstract). The Appellants assert and we agree that the disclosure in Kaneko of “sucrose alkyl ester” in the composition is a disclosure of the broad genus of saccharide esters. However, Formula (I) of the claimed invention encompasses nine subgeneric categories of compounds. (App. Br. 13). The Examiner has not adequately explained how Kaneko’s generic disclosure of “a mixture’ of sucrose alkyl esters” anticipates the claimed invention. The citation to the compound in the Mitsubishi Kagaku Internet publication does not change Kaneko’s scope of disclosure of saccharide esters.

Under these circumstance, we cannot conclude that the Examiner has met the minimum threshold of establishing anticipation under 35 U.S.C. § 102. Therefore, the rejections of claims 1-18, 67, and 71-85 under § 102 is reversed.

ORDER

The decision of the Examiner rejecting claims 1-18, 67, and 71-85 under 35 U.S.C. § 102(b), is reversed.

REVERSED

tc

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